

Amendment

Application No. 10/071,490 (60019660-0021)

Page 4

### REMARKS

In view of the foregoing, Applicant submits that the pending claims comply with the requirements of 37 CFR 1.121.

Upon entry of this amendment, claims 97, 98, 103, and 104 will be pending in the above-identified application. Claims 95-96, 100-102 have been canceled herein. Claim 104 has been added and claims 97, 98 and 103 have been amended. The instant amendment focuses the application on particularly patentable aspects in order to expedite allowance and issuance thereof. No new matter has been added.

Reconsideration and allowance of all pending claims are respectfully requested in view of the amendments and the following remarks.

#### Anticipation Claim Rejections - 35 U.S.C. § 102(b)

Claims 95-98 and 102-103 were rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0522569 (Sander et al.). Claims 95, 96, and 102 have been canceled rendering the rejection moot as to those claims. Applicant respectfully traverses the anticipation rejection and requests reconsideration and withdrawal thereof to the extent it may apply to now pending claims 97, 98, 103 and 104 as amended.

To anticipate a claim, a reference must teach, expressly or inherently, each and every element required by the claim as interpreted by one of ordinary skill. MPEP § 2131. Sander et al. does not anticipate the pending claims, because the reference does not teach each and every element required by the subject claims. For example, claim 104 (from which the remaining claims depend) requires the claimed composition contain 5-30% non-decalcified bone matrix. Sander et al. fail to teach its inclusion in their composition. Moreover, the subject claims are to a composition "consisting essentially of" four components. In contrast, Sander et al. urges the inclusion of a multitude of other ingredients, and hence, fail to teach this element as well. Further, while, as stated in the pending Office action, Sander et al. do list, at page 4, lines 33-42, demineralized bone powder and morselized cancellous bone as among many potential additives of bioactive substances, there is no indication as to what portion of the total composition they would entail. Indeed, the only disclosure of the likely proportion that the "bioactive substances" would have to the total of the Sander et al. composition is the suggestion that the major ingredients could be "soaked in a bath" (Sander, et al., page 4, lines 22-23) containing these bioactives, indicative that these are proportionately significantly less than the major components they represent in applicant's claimed composition. Hence, Sander et al. not

Amendment

Application No. 10/071,490 (60019660-0021)

Page 5

only does not teach, but the reference clearly does not suggest these many elements of the pending claims.

Accordingly, the PTO has not established anticipation for claims 98, 99, 103 and 104 by Sander et al. Applicant, therefore, requests reconsideration and withdrawal of the rejection of these claims under 35 U.S.C. § 102(b).

#### Anticipation Claim Rejections - 35 U.S.C. § 102(e)

Claims 95-98 and 102-103 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,049,026 (Muschler). Claims 95, 96, and 102 have been canceled rendering the rejection moot as to those claims. Applicant respectfully traverses the anticipation rejection and requests reconsideration and withdrawal thereof to the extent it may apply to now pending claims 97, 98, 103 and 104 as amended. A prior art reference must be considered in its entirety for what it teaches. MPEP § 2141.02. A fair reading of Muschler unequivocally shows that the fundamental ingredient for its implantable graft is a bone marrow aspirate. It states: "The present invention provides a new and improved method for preparing a composite bone graft. The method comprises collecting a bone marrow aspirate from a donor, preferably in the presence of an anti-coagulant to provide a bone marrow aspirate suspension, and passing the bone marrow aspirate suspension through a porous, biocompatible implantable substrate. Preferably, the substrate is sterile. Preferably, the method is performed intra-operatively using a bone marrow aspirate preferably from the grafted." (Muschler, col. 3, lines 22-32.)

Since applicant's instant claims require the exclusion of the fundamental ingredient taught and suggested by Muschler for its graft, Muschler clearly is not an anticipatory reference; and moreover, does not suggest (in fact teaches away from) the invention embodied in the pending claims.

Accordingly, Applicant requests reconsideration and withdrawal of the rejection of these claims under 35 U.S.C. § 102(e) .

#### Obviousness Claim Rejections - 35 U.S.C. § 103(a)

Claims 95-98 and 102-103 were rejected in the alternative under 35 U.S.C. § 103(a) as being obvious solely over EP 0522569 (Sander et al.); claims 95-98 and 102-103 were rejected in the alternative under 35 U.S.C. § 103(a) as being obvious solely over U.S. Patent No. 6,049,026 (Muschler); and Claims 99-101 were rejected under 35 U.S.C. § 103(a) as being obvious solely over EP 0522569 (Sander et al.). Claims 95, 96, 99-102 have been canceled rendering the rejection moot as to those claims. Applicant respectfully traverses the

Amendment

Application No. 10/071,490 (60019660-0021)

Page 6

obviousness rejections and requests reconsideration and withdrawal thereof to the extent they may apply to now pending claims 97, 98, 103 and 104 as amended. In order to establish obviousness of a claim, the PTO must show, *inter alia*, that the prior art reference(s) teach or suggest all of the claim limitations. MPEP § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2D 1438 (Fed. Cir. 1991). As delineated above, Sander et al. and Muschler do not teach or suggest all the claim limitations of pending claims 97, 98, 103 and 104. Accordingly, Applicant therefore requests reconsideration and withdrawal of the rejections of these claims under 35 U.S.C. § 103(a).

Amendment  
Application No. 10/071,490 (60019660-0021)  
Page 7


### CONCLUSION

An American Express Credit Card Payment Form is attached for payment of the \$60.00 one month extension of time fee. Any deficiency or overpayment of the required fee should be charged/credited to Deposit Account No. 19-3140.

If the Examiner believes that there is any issue which remains to be resolved, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Dated: March 7, 2006

Respectfully submitted,

  
G. Harley Blosser  
Customer No. 26263  
314.259.5806

23187731\W-1